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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/776,658 02/05/01 DEMAREST

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QM12/0815

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EXAMINER

DEXTER C  
ART UNIT PAPER NUMBER

3724  
DATE MAILED:

08/15/01

*6*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/776,658

Applicant(s)  
Demarest et al.

Examiner  
Clark F. Dexter

Art Unit  
3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 25, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-39 is/are pending in the application.
- 4a) Of the above, claim(s) 30-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Group I (claims 21-29) in the response filed May 25, 2001 (paper no. 5) is acknowledged. The restriction requirement has been traversed by applicant, but is not found persuasive because for the following reasons.

First, applicant argues that the inventions are not independent and distinct. The Examiner respectfully disagrees. The four groups are considered to be directed to separate inventions, specifically, subcombinations useable together, and are considered to be independent and distinct. The authority for such Restriction requirements is set forth in Chapter 800 of the MPEP. It is noted that although two-way distinctness has been demonstrated in the restriction requirement, only one-way distinctness is required. Further, it is noted that the showing of separate status in the art is generally a showing of undue burden on the Examiner to examine all of the inventions together (which is also required for Restriction). The restriction requirement is based upon applicant's presentation of the claims and what features of the invention are relied upon to distinguish the invention over the prior art. The Examiner has merely grouped claims directed to the same inventions (e.g., subcombinations) together in the listed groups. If it is applicant's position that the inventions are not independent and distinct, one from the other (i.e., that each group does not require individual consideration as to patentability), applicant should make such a statement in the next response and that group or those groups of claims will be examined along

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with the elected group. It is noted, however, that such a statement may be used as an admission of obviousness and thus may be used in a rejection under 35 U.S.C. 103(a) of the non-distinct invention.

In the fifth paragraph on page 3 of the response, applicant argues that because all of the claims depend from the same independent claim, they are not independent and distinct. The basis for applicant's argument is not understood. As applicant is well aware, all claims are considered as independent claims, wherein dependent claims are simply written in short hand form. Thus, whether a claim is an independent claim or a dependent claim is merely a matter of form. Further, all of the groups include claim 21. Therefore, the subject matter of claim 21 is not considered independent or distinct from any of the groups and thus will be examined with the elected group. Again, the Examiner has simply grouped together all of the claims directed to a single invention (i.e., subcombination).

In the first paragraph on page 4 of the response, applicant points out that "the courts have recognized that it is the public interest to permit applicants to claim several aspects of their invention together in one application." The Examiner does not disagree, and restriction is not contrary to this position. Applicant has not been prohibited in any way from claiming "all aspects as to what they regard as their invention." However, applicant has presented claims in a manner which sets forth various inventions (i.e., subcombinations), and due to the limited time and resources available to prosecute a single invention, applicant is being required to elect an

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invention for examination in the present application. Claims directed to other inventions may be pursued in a Continuing or Divisional application.

In the fourth paragraph on page 4 of the response, applicant suggests "that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts." The Examiner agrees, and applicant can be certain that a restriction requirement has not been "arbitrarily imposed" in this application. As previously stated, applicant has presented the claims and set forth features in the claims that are directed to various subcombinations of the invention which are to be relied upon to distinguish the invention over the prior art. The Examiner has merely grouped claims directed to the same subcombinations together in the listed groups. Further, it is emphasized that the examination of multiple inventions (i.e., subcombinations) in the time allotted for a single invention creates an undue burden on the Examiner, particularly since multiple inventions results in multiple fields of search and multiple scopes of invention leading to multiple patentability considerations. However, to relieve Applicant's burden, Applicant may state that one or some of the groups are not patentably distinct and the claims directed to this group or these groups will also be examined. It is again noted, however, that such a statement may be used as an admission of obviousness and may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

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***Information Disclosure Statement***

2. The information disclosure statement filed March 22, 2001 (paper #2) has been received and the references listed thereon have been considered.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 21-29 are rejected under the judicially created doctrine of non-statutory double patenting over claims 1-21 of U.S. Patent No. 6,128,816. Although the conflicting claims are not identical, they are directed to the same inventive concept and are not patentably distinct from each other because the subject matter of the application claims is fully disclosed in the patent specification and covered by the patented claims. The patented claims are inclusive for they are drafted using the "comprising-type" format and cover the subject matter of the application claim(s). Since applicant has obtained the right to exclude others from making and using the


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subject matter set forth in the claims of this application by virtue of the patented claims, the issuance of this application into a patent without a terminal disclaimer as provided for under 37 CFR § 1.321(b) would amount to an unjustified extension of this right.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

  
**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cfd  
August 13, 2001